

Docket No.: SS-108

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

App. No.: 10/764,029)	Examiner: Walczak, David J.
)	
Title: CLIP WITH SLIDABLE MEMBER)	Art Unit: 3751
)	
Inventor: Cetera, Carl)	
)	
Filed: 01/22/2004)	
)	

REQUEST FOR CONTINUED EXAMINATION

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

I. Summary of Last Office Action

On March 13, 2006, the Examiner mailed a final office action in relation to the application identified above. The Examiner rejected Claims 1-5 under 35 U.S.C. 102(b) as being anticipated by US Patent number 6,332,247 issued to Hsieh ("Hsieh reference"). The Examiner objected to Claims 6-10 as being dependent upon a rejected base claim, but indicated that they are allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

II. Applicant's Submission

A. Request for Continued Examination

Applicant requests continued examination of the non-provisional application identified above under 37 CFR 1.114 by filing a submission and fee set forth in 37 CFR 1.17(e). The submission includes an amendment to claims and arguments in support of patentability.

B. Allowable Subject Matter in Claims 6-10

Following the Examiner's suggestion for allowance indicated in the final Office Action, Claim 6 has been rewritten as new independent Claim 28 including all elements and limitations of its base claim, Claim 3, except for a slight change in the language of descriptions adopted for giving further clarity to the claim, which, Applicant believes, constitutes neither new element nor new limitation. Claim 7, 8, and 10 have been accordingly rewritten as new dependent Claims 29-31 respectively. Claims 6-10 have been then canceled. Applicant added new Claims 32-37, dependent from Claim 28, which are believed to be allowable as well in the respect that Claim 28 is believed so.

C. Amended Independent Claims 1, 3, Dependent Claims 4, 5, and New Dependent Claims 15-27 Are Not Anticipated by the Hsieh Reference.

As understood by Applicant, the Hsieh reference discloses a writing instrument with a two-piece clip comprising a ferrule, a clip member, and optionally an ornamental or advertising article to be attached to the ferrule and clip. The Hsieh reference cannot anticipate Claims 1 and 3 as amended because the article 30 in the Hsieh reference is not so structured to be 'movable upwardly and downwardly between the upper and the lower clip ends,' on the parallel rails as

required by Claims 1 and 3.

In the last office action, the Examiner maintained that such feature of slidability of the member has not been claimed.¹ Although Applicant still believes that the feature of the member's slidability has been adequately claimed by the use of the adjective, "slidable," placed before the word "member" in reading the language of Claims 1 and 3, Applicant herein amends Claims 1 and 3 to further describe that feature by adding the language, "the slidable member [is] connected with said at least one pair of parallel rails and configured such that said member is movable upwardly and downwardly between the upper and the lower clip ends," which is essentially the identical language appearing in the Claim 6 that the Examiner found allowable. The slidable member must be structured, i.e., configured and connected to the rails, such that it can move upwardly and downwardly between the upper and the lower clip ends. Applicant believes that by such amendment, the structural feature of slidability of the member at issue has been claimed sufficiently, and undisputably.

Evidently, the Hsieh reference fails to disclose this structural limitation. Anticipation requires that each and every element of the claimed invention be disclosed in the prior art reference. *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 1241, 1245 (Fed. Cir. 1987).

¹. Applicant respectfully disagrees with such assessment of the claim by the Examiner. Applicant directs the Examiner's attention to the adjective "slidable" placed before the word "member" in reading the language of Claims 1 and 3. That word, "slidable," was not used in vanity or without meaning. It has been used to represent, plainly, the requirement that the member be structured such that it is slidable on the parallel rails during the ordinary, intended use of the present invention. Also, it has been used to denote that the limitation is separate from, and additional to, the limitation that the member is slidably attached to the rails during the assembly process. The slidability of the member is the central structural feature and major novelty of the present invention. As a matter of fact, it is the whole purpose of making the clip as parallel rails in the present invention. This feature and the purpose of the rails on a clip as related to it have been disclosed expressly, and repeatedly, throughout the specification and the drawings. Applicant respectfully maintains that the claim language, "slidable" should have been read and construed in light of the specification and claims as a whole. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996).

Although drawings and pictures can anticipate claims if they clearly show the structure which is claimed, *In re Mraz*, 455 F.2d 1069; MPEP 2125, the picture must show all the claimed structural features and how they are put together. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928); MPEP 2125.

As Applicant understands, nothing in the Hsieh reference indicates or suggests that the article **30** is ever slidable or movable upwardly and downwardly on the clip. Instead, the Hsieh reference describes the ornamental article **30**, as merely being connected, via one or two insertion holes located at the backside of the article, to the two free ends **123** of the rails at the upper clip end. (See Col. 3, Ins.15-29; See also FIGS. 1, 2, and 5). But, the distinction of the clip in the Hsieh reference from the current invention does not merely come from the failure of the Hsieh reference in affirmatively disclosing the feature of slidability of the article **30**. More importantly, the Hsieh reference is distinguishable because the disclosed structure of its clip-pen assembly makes it impossible for the article **30** to move, even if one attempts so, upwardly and downwardly between the two clip ends. As the FIGS. 1, 2, and 5 shows, the article **30** appears fixedly attached to the end of the clip, being pierced by the free ends of the rail through the backside insertion holes only partly, rather than completely through, and thus, prevented from further sliding downward on the rails. Moreover, the article **30** cannot move downward because, above of all, it is blocked, and thus physically separated from the rest part of the rails by the ferrule 11. The article's such structural incapability of sliding on the clip is understandable because the article **30** of the Hsieh reference is intended and employed only for ornamental purpose, for which slidability would be irrelevant and unneeded.

In summary, the Claim 1 and 3 requires that the member be connected on the rails of the clip and structured such that it is movable upwardly and downwardly between the upper and the

lower clip ends. The article **30** of the Hsieh reference, however, is not so connected and structured. Nor did the Examiner suggest in the Office Action, as Applicant understands, that the Hsieh reference discloses such limitation of slidability. Since the Hsieh reference plainly fails to disclose one of the structural limitations of amended independent Claims 1 and 3, Applicant respectfully submits that amended independent Claims 1 and 3 should be deemed distinguishable from the Hsieh reference. In that respect, their dependent Claims 4, 5, and 15-27 are also believed to be distinguishable from the Hsieh reference.

D. Amended Claims and New Claims Do Not Contain New Matter.

Claims 1, 3, and 4 have been amended to provide further consistency and clarity to the claims as well as to present the invention at issue in a form distinct from the prior art reference cited by the Examiner. In amended Claims 1 and 3, the limitation requiring the slidable member to be “slidingly articulated upon” the rails has been dropped, wherein the slidable member is required to be merely “connected with” the rails, thereby allowing other ways of connection. Applicant submits that there is no issue of new matter involved in such removal of the limitation because the application as filed clearly allows “other ways of articulating a slidable member on one or more rails” such as connection via two channels on the slidable member. (*See* Application at page 6, lines 13-17). Also, in amended Claim 3, the limitation that the rails are connected at the lower clip end is removed, the removal of which does not constitute new matter because a clip with rails without such limitation has been disclosed in Claim 1.

New dependent Claims 15, 27, and 36 have a new limitation that the slidable member is detachable from, and reconnectable with the rails, which is not new matter because the specification discloses it. (Application at page 8, lines 17-26). New Claims 16 and 33 have the

same limitation with Claim 4 that the rails are formed as metal wires. New Claims 17 and 23 have the limitation that the rails are connected at the lower clip end, which was disclosed in pre-amended Claim 3. New Claim 18 has the limitation that the slidable member is composed of three segments and the middle segment is smaller in diameter than the other two to fit between the rails, which is also disclosed in canceled Claim 6. New Claims 19-21, and 29-31 have the identical limitations that were disclosed in canceled Claims 7, 8, and 10 respectively. New Claims 22, 26, and 37 have a new limitation that the slidable member has channels configured such that the rails pass through them, which is not new matter because the original specification discloses it. (Application at page 6, lines 15-16; page 7, lines 15-16). New Claims 24 and 34 have a new limitation that the rails are bent near the lower clip end to form thereon a clipping portion that is biased against the instrument body, which either is not new matter because the original specification discloses it. (Application at page 5, lines 20-23). New Claims 25 and 35 have a new limitation that the rails at the upper clip end are inserted into connection holes on the body of the instrument, which is not new matter because the original specification discloses it. (Application at page 5, line 28). Finally, new Claim 32 has the identical limitation with Claim 5.

As seen above, all elements and limitations in amended Claims 1-5 and new Claims 15-37 are disclosed either in pre-amended claims or in the rest part of the specification as filed, and thus, do not constitute new matter.

III. Conclusion

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and requests that such action be taken by the Examiner.

Respectfully Submitted,

Date: 03/24/2006

By:



Woo Soon Choe

Registration No. 56,726

THE SONI LAW FIRM

55 S. Lake Avenue, Suite 720

Pasadena, CA 91101

Phone: (626) 683-7600

Fax: (626) 683-1199

Email: woosoon@sonilaw.com

CLAIMS (Marked-Up)

What is claimed is:

1. **(CURRENTLY AMENDED)** A clip for a handheld instrument, said clip having an upper clip end and a lower clip end, said clip comprising:
 - a) at least one ~~track comprising pair of two~~ parallel rails;
 - b) a slidable member~~[[,]] slidably articulated upon~~ connected with said at least one pair of parallel rails and configured such that said member is movable upwardly and downwardly between the upper and the lower clip ends.
2. **(CANCELED)**
3. **(CURRENTLY AMENDED)** A handheld instrument comprising:
 - a) an elongated instrument body;
 - b) a clip comprising ~~a track comprising at least one pair of two~~ parallel rails, and said clip having an upper clip end and a lower clip end~~[[,]]~~,
~~c. said lower end of the clip connecting said rails together;~~
~~d. said the upper clip end of the clip being~~ connected with said elongated instrument body;
and
~~e. c)~~ c) a slidable member~~[[,]] slidably articulated upon~~ connected with said at least one pair of parallel rails and configured such that said member is movable upwardly and downwardly between the upper and the lower clip ends.
4. **(CURRENTLY AMENDED)** A handheld instrument as in claim 3, wherein said at least one pair of rails are ~~comprised of~~ formed as metal wires.
5. **(ORIGINAL)** A handheld instrument as in claim 3, wherein said handheld instrument is a writing instrument.

6.-12. (CANCELED)

13. (WITHDRAWN) A method for advertising or promotion comprising the steps of:

a) fabricating a clip for a handheld instrument which has at least one ~~track comprising two~~
pair of parallel rails and a slidable member[[,]] slidingly articulated connected with said at
least one pair of parallel rails and configured such that said member is movable upwardly and
downwardly between the upper and the lower clip ends; and

b) imprinting graphical or printed material on at least one visible surface of said sliding member.

14. (CANCELED)

15. (NEW) A clip as in claim 1, wherein said slidable member is detachable from, and reconnectable with, said at least one pair of rails.

16. (NEW) A clip as in claim 1, wherein said at least one pair of rails are formed as metal wires.

17. (NEW) A clip as in claim 16, wherein said at least one pair of rails are connected at the lower end.

18. (NEW) A clip as in claim 17, wherein said slidable member comprises a bottom segment, a middle segment, and a top segment, and said middle segment is smaller in diameter than the other two segments to fit between said at least one pair of rails.

19. (NEW) A clip as in claim 18, wherein said slidable member further comprises advertising indicia imprinted upon said middle segment and below said top segment, and said top segment is fabricated from transparent material such that said indicia is visible.

20. (NEW) A clip as in claim 18, wherein said slidable member further comprises advertising indicia imprinted upon an outer surface of said top segment such that said indicia is visible.

21. (NEW) A clip as in claim 20, wherein said indicia is imprinted with three dimensional

textures, whereby further sensory input is provided to the user of the handheld instrument.

22. (NEW) A clip as in claim 17, wherein said slidable member defines channels configured to receive said at least one pair of rails therethrough.
23. (NEW) A handheld instrument as in claim 4, wherein said at least one pair of rails are connected at the lower clip end.
24. (NEW) A handheld instrument as in claim 23, wherein said at least one pair of rails are bent away from said instrument body adjacent the lower clip end, thereby defining a clipping rail portion which is biased against said instrument body for clipping an article therebetween.
25. (NEW) A handheld instrument as in claim 24, wherein said elongated instrument body defines thereon connecting holes which receive therein said at least one pair of rails at the upper clip end.
26. (NEW) A handheld instrument as in claim 3, wherein said slidable member defines channels configured to receive said at least one pair of rails therethrough.
27. (NEW) A handheld instrument as in claim 3, wherein said slidable member is detachable from, and reconnectible with, said at least one pair of rails.
28. (NEW) A handheld instrument comprising:
- a) an elongated instrument body;
 - b) a clip having an upper clip end and a lower clip end, said clip comprising at least one pair of parallel rails, the lower clip end connecting said at least one pair of rails together, the upper clip end being connected with said elongated instrument body; and
 - c) a slidable member, slidably articulated upon said at least one pair of parallel rails, said slidable member comprising a bottom segment, a middle segment, and a top segment wherein said middle segment is smaller in diameter than the other two segments to fit between said at

least one pair of rails such that said slidable member is movable upwardly and downwardly between the upper and the lower clip ends.

29. (NEW) A handheld instrument as in claim 28, wherein said slidable member further comprises advertising indicia imprinted upon said middle segment and below said top segment, and said top segment is fabricated from transparent material such that said indicia is visible.
30. (NEW) A handheld instrument as in claim 28, wherein said slidable member further comprises advertising indicia imprinted upon an outer surface of said top segment such that said indicia is visible.
31. (NEW) A handheld instrument as in claim 30, wherein said indicia is imprinted with three dimensional textures, whereby further sensory input is provided to the user of the handheld instrument.
32. (NEW) A handheld instrument as in claim 28, wherein said handheld instrument is a writing instrument.
33. (NEW) A handheld instrument as in claim 28, wherein said at least one pair of rails are formed as metal wires.
34. (NEW) A handheld instrument as in claim 33, wherein said at least one pair of rails are bent away from said instrument body adjacent the lower clip end, thereby defining a clipping rail portion which is biased against said instrument body for clipping an article therebetween.
35. (NEW) A handheld instrument as in claim 28, wherein said elongated instrument body defines thereon connecting holes which receive said at least one pair of rails at the upper clip end.
36. (NEW) A handheld instrument as in claim 28, wherein said slidable member is detachable

from, and reconnectable with, said at least one pair of rails.

37. (NEW) A handheld instrument as in claim 28, wherein said slidable member defines channels configured to receive said at least one pair of rails therethrough.